

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 27-Apr-05 APPL. S.N.: 09/741,639
 TO: EXAMINER BAYARD, EMMANUEL ART UNIT: 2631
 FROM: Jefferson, Henry
 PARALEGAL SPECIALIST

Case Drop-Off Location
 RETURN THIS MEMO TO: JEF-2D68

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 13-Dec-04

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. **THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE.** When your action is complete, please initial, date and return this memo to me. **THANK YOU.**

- ☐ The T.D. is PROPER and has been recorded (see ¶ 14.23).
- ☒ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):
- ☒ The TD fee of \$130.00 has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
 - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶ 14.26 & 14.26.01).
 - ☐ The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
 - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since “the disclaimer must be for a terminal portion of the term of the entire patent to be granted” (MPEP 1490) (see ¶ 14.26 & 14.26.02).
 - ☐ The person who signed the T.D.:
 - ☐ is not an attorney “of record” (see ¶ 14.29 and 14.29.01).
 - ☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
 - ☐ is not recognized as an officer of the assignee (see ¶ 14.29 & possible 14.29.02).
 - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
 - ☐ The T.D. is not signed (see ¶ 14.26 & 14.26.03).
 - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
 - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶ 14.26, 14.27.02 or 14.26.05).
 - ☐ The period disclaimed is incorrect or not specified (see ¶ 14.26, 14.27.02 or 14.26.03).
 - ☐ Other:
 - ☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: _____ Date: _____

Log Date: _____

DEC 13 2004

MICHAELSON & ASSOCIATES

Parkway 109 Office Center, 928 Newman Springs Road, P.O. Box 8489, Red Bank, New Jersey (USA) 07701

Date: December 13, 2004

Number of pages,
including cover sheet: 9To: Examiner Guy J. Lammere
US Patent and Trademark Office
GAU 2133Phone:
Fax: 703-872-9306From: Peter L. Michaelson, Esq.
Michaelson & AssociatesPhone: (732) 530-6671
Fax: (732) 530-6584 or -6585
E-mail: p_michaelson@mandw.com
Web Site: http://www.mandw.comREMARKS: ☒ FOR FILING ☐ For your review ☐ Reply ASAP ☐ Please Comment**CONFIDENTIALITY NOTE:**

The information contained in this facsimile message is legally privileged, confidential and intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient, then you are not to disseminate, distribute or copy this facsimile under any circumstances. If you have received this facsimile in error, please immediately notify us by telephone: (732) 530-6671 or return facsimile.

MESSAGE: Applicants: Vlad MITLIN, Richard G.C. WILLIAMS Atty. Doc.: 3Com-72/1(3292TDCUSP)
Serial No.: 09/741,363-09/741,439 Filed: December 20, 2002
Group Art Unit: 2133 Confirmation No.: 5636 Examiner: Guy J. Lammere
Title: PERFORMANCE EVALUATION OF MULTICARRIER CHANNELS

Attached for filing please find the following:

1. "No Fee" Transmittal letter (in duplicate); and
2. Substitute Terminal Disclaimer.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (and any accompanying paper(s)) is being facsimile transmitted to the United States Patent Office on the date shown below.

Cornelia Arens

Type or print name of person signing certification

Signature

December 13, 2004
Date

22470

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

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Applicants: Vlad MITLIN, Richard G.C. WILLIAMS

Atty. Doc.: 3Com-72/1(3292TDCUSP)

Serial No.: 09/741,385⁶³⁹ Filed: December 20, 2002

Group Art Unit: 2133

Confirmation No.: 5636

Examiner: Guy J. Lemarre

Title: PERFORMANCE EVALUATION OF MULTICARRIER CHANNELS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450


S I R:

I believe that no fee, of any kind, is required for the accompanying Substitute Terminal Disclaimer which is being submitted in response to the Communication (Paper No. 20040827) mailed December 9, 2004 in connection with the above-captioned application.

In the event a fee is due, kindly charge that fee to my deposit account number 13-3083. To facilitate that charge, a duplicate copy of this letter is enclosed herewith.

Respectfully submitted,

December 13, 2004


Peter L. Michaelson, Attorney
Reg. No. 30,090
Customer No. 007265
(732) 530-6671

Page 1 of 2

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(300072-180FBI/IR/csl:169)

Page 2 of 2

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants: Vlad MITLIN, Richard G.C. WILLIAMS

Atty. Doc.: 3Com-72/1(3291TDCUSP)

Serial No.: ^{09/741639}
~~09/741,383~~

Filed: December 20, 2002

Group Art Unit: 2133

Confirmation No.: 5636

Examiner: Guy J. Lamarre

Title: PERFORMANCE EVALUATION OF MULTICARRIER CHANNELS

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Page 1 of 2

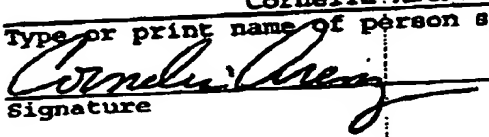
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December 13, 2004
Date

{3CON72-180PBLTR/ca:100}

Page 2 of 2

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

PATENT APPLICATION

Applicants: Vlad MITLIN, Richard G.C. WILLIAMS

Atty. Doc.: 3Com-72/1(3292TDCUSP)

Serial No.: 08/741,353 ⁰⁹⁷⁴¹⁶³⁹ Filed: December 20, 2002

Group Art Unit: 2133

Confirmation No.: 5636

Examiner: Guy J. Lamarre

Title: PERFORMANCE EVALUATION OF MULTICARRIER CHANNELS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

**SUBSTITUTE TERMINAL DISCLAIMER TO OBVIATE A
DOUBLE PATENTING REJECTION OVER PRIOR PATENT
AND
CO-PENDING PATENT APPLICATION**

3Com Corporation, the owner of 100 percent interest in the instant application, by virtue of an assignment to 3Com Corporation recorded on December 20, 2000 at reel 011398, frame 0609, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,732,323 (assignment to 3Com Corporation recorded

January 29, 2001 at reel 011487, frame 0127). The owners hereby agree that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

3Com Corporation also hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of any patent issued on co-pending patent application serial number 09/741,639 (Publication No. 2002/0108081; the "co-pending" application -- assignment to 3Com Corporation recorded December 19, 2000, reel 011401, frame 0686). The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent issued on the co-pending patent application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent or of any patent issued on the co-pending patent application, as presently shortened by any terminal disclaimer, in the event that the latter:

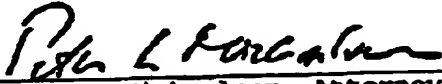
expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Terminal disclaimer fee under 37 CFR 1.20(d) in the amount of \$ 110.00 was previously paid. In the event this an additional fee is required, please charge the additional or entire cost, as appropriate, to Deposit Account No. 13-3083. To facilitate that charge, a duplicate copy of this document is enclosed herewith.

Respectfully submitted,

December 13, 2004

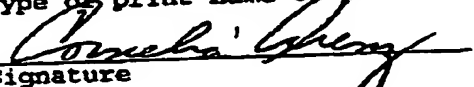

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